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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,883	03/12/2001	Leo I. Rainer	00-240	5679

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William S. Bernheim
255 N. Lincoln St.
Dixon, CA 95620

EXAMINER

CIRIC, LJILJANA V

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,883

Applicant(s)

RAINER ET AL.

Examiner

Ljiljana (Lil) V. Ciric *AKC*

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-51 is/are pending in the application.
4a) Of the above claim(s) 45-51 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 32-44 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office action is in response to the reply filed on April 18, 2005.
2. Claims 32 through 51 remain in the application, all as amended either directly or indirectly.

Response to Arguments

3. Applicant's arguments filed on April 18, 2005 have been fully considered but they are not persuasive.

Applicants arguments relating to the election/restriction requirement fail to address the issues relating to inventions constructively elected by original presentation for prosecution on the merits.

Applicant is respectfully advised to more carefully review the election/restriction section in the previous Office action which is essentially repeated below.

As a preface to the examiner's traversal of applicant's arguments relating to the applicability of the Nakamura reference, applicant is first of all respectfully reminded that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). The broadest reasonable interpretation of the claims of the instant invention requires, for example, that, since no specific structure is recited in the claims to distinguish the controller of the instant invention from known prior art controllers, that any prior art controller operably connected to a sensor system and an air delivery system be readable on the controller as recited in the claims of the instant invention. Similarly, the broadest reasonable interpretation of the limitation "an air delivery system" requires that this term be readable on any prior art air handling unit or air conditioning system since each of these is inherently an air delivery system.

Applicant is furthermore also respectfully reminded that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847;

Art Unit: 3753

120 USPQ 528, 531 (CCPA 1959). Also, A[A]pparatus claims cover what a device *is*, not what a device *does*. (Emphasis in original). Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus while all limitations in the examined apparatus claims have been considered by the examiner, functional limitations not supported by a corresponding recitation of distinguishing structure do not impart patentability to apparatus claims where the prior art anticipates the claimed structural limitations of the apparatus claims.

In response to applicant's arguments that Nakamura fails to disclose a system for using outside ventilation air to maintain indoor comfort and air quality, the recitation that the invention is drawn to system for using outside ventilation air to maintain indoor comfort and air quality has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Alternately with regard to applicant's arguments that Nakamura fails to disclose a system which includes an air delivery system for delivering outside ventilation air to an interior space, the examiner hereby notes that Nakamura most certainly discloses an air conditioning apparatus, and an air conditioning apparatus inherently includes an air delivery system. Furthermore, a recitation of the intended use of the claimed invention *must* result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Art Unit: 3753

In response to applicant's arguments that Nakamura fails to disclose a controller that regulates operation of the air delivery or air conditioning system but rather merely generates messages for the user, the examiner notes that even if this were the total extent of the controller 12 of Nakamura, the messages to the user are a way of regulating the operation of the air delivery system that is inherent to the air conditioning apparatus 8.

In response to applicant's argument that the Nakamura reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that a controller which performs a particular function must be programmed or "hard wired" in order to be capable of performing the particular function) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Election/Restrictions

4. Amended and previously newly submitted claims 45 through 51 are now improperly dependent on claim 32 and are *still* directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 45 through 51 are drawn to a process, whereas originally presented claims 1 through 24 are drawn to an apparatus. An apparatus and a process are distinct by definition if it can be shown that either: (1) the process as claimed can be practiced by another

Art Unit: 3753

materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced using an apparatus, which unlike the inventive apparatus as originally claimed, does not necessarily have either a user interface or a damper means directing air flow using a first and second position. Alternately, the originally claimed apparatus, can be used to practice a process which, unlike the newly claimed process, requires using the buttons on a user interface for establishing control settings. Because these inventions are distinct for the reasons given above and the search required for the process claims as newly presented is not required for the apparatus claims as originally presented, and since applicant has received an action on the merits for the originally presented invention (i.e., the apparatus), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45 through 51 are hereby still withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It appears that the limitation “further comprising an air conditioner” in claim 41 represents a double recitation of the air delivery system already recited in base claim 32, since the air delivery system encompasses an air conditioner.

Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationship is the structural relationship between the controller and the air conditioner.

Art Unit: 3753

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. As best can be understood in view of the indefiniteness of claim 41, claims 32 through 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura ('944).

Nakamura ('944) discloses a sensor system including: sensors 1 and 11; an air delivery system including air conditioning apparatus 10; a controller 12 operably connected to both the air conditioning apparatus/air delivery system 8 and to the sensor system including sensors 1 and 11; and, a user interface including an input terminal device 13 and an output terminal device 14. Little or no *patentable* weight is given to purely functional language and optional/conditional limitations in the apparatus claims.

The reference thus reads on the claims.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3753

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric whose telephone number is 571-272-4909. The examiner can normally be reached on Mondays through Fridays from 10:00 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene, can be reached at 571-272-4930.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ljiljana (Lil) V. Ciric
Primary Examiner
Art Unit 3753